

Appln. No. 10/064,589
Docket No. 124615 / GEM-0032

REMARKS / ARGUMENTS

Status of Claims

Claims 1-3, 5-10, 12-27 and 29-31 are pending in the application and stand rejected. Applicant has amended Claims 1, 6, 12, 16, 21, 27 and 31, and has added new Claims 32-34, leaving Claims 1-3, 5-10, 12-27 and 29-34 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

Claims 1-3, 5-10, 12-21, 23-26 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aoki et al. (U.S. Patent No. 6,275,128 B1, hereinafter Aoki) further in view of Rimkunas et al. (U.S. Patent No. 6,566,991 B1, hereinafter Rimkunas).

Claims 22 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aoki and Rimkunas, and further in view of Rapoport (U.S. Patent No. 6,670,877 B2, hereinafter Rapoport).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Regarding Claims 1-3, 5-10, 12-21, 23-26 and 29-31

Applicant has amended independent Claims 1, 6, 12, 16, 21 and 31 to include, inter alia, the elements of "... said plurality of shims each have a top edge and a bottom

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edge separated by a distance h and a center defined by the distance h/2 between said top edge and said bottom edge... said plurality of centers being allowed to be non-planar...", which finds support in the specification as originally filed at Paragraphs [0028] and [0033-0035], and at Figures 3, 4, 7 and 9.

At Paragraphs [0033-0035] and Figures 7 and 9, Applicant discloses shims 18 having a top edge 80 and a bottom edge 82 separated by a distance h, which inherently has a center defined by the distance h/2.

At Paragraph [0033], Applicant discloses that bottom edge 82 is positioned proximate to surface 16.

At Paragraph [0028] and Figures 3, 4, 7 and 9, Applicant discloses surface 16 as defining a plane.

At Paragraph [0035] and Figure 9, Applicant discloses that height h may vary.

Accordingly, Applicant's specification as originally filed discloses a plurality of shims 18 each having a top edge 80 and a bottom edge 82 separated by a distance h and a center defined by the distance h/2 between the top edge 80 and the bottom edge 82, such that, by virtue of bottom edge 82 being positioned on a planar surface 16 and the height h across the plurality of shims 18 being variable, the centers of shims 18 are allowed to be non-planar.

Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim.

In comparing the instant invention with the References, Applicant submits that the References fail to teach or suggest a plurality of shims each having a top edge and a bottom edge separated by a distance h and a center defined by the distance h/2 such that the centers are allowed to be non-planar, as claimed.

In fact, Rimkunas teaches different sizes of spheres of different magnetic material "such that the centers of all shimming spheres are aligned in the same plane." Col. 7, lines 61-62, and Figures 1-3. (Emphasis added). In view of Rimkunas being absent any teaching to the contrary, it follows that Rimkunas in combination with Aoki is absent any teaching that would enable one skilled in the art to arrive at the claimed invention.

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Claims 22 and 27

Applicant has amended Claim 27 to include language similar to that of Claims 1, 6, 12, 16, 21 and 31. Claim 22 depends from Claim 21.

For all the reasons set forth above regarding Claims 1, 6, 12, 16, 21 and 31, Applicant submits that the combination of Aoki, Rimkunas and Rapoport fail to teach or suggest each and every element of the claimed invention, and specifically fail to teach or suggest the elements of a plurality of shims each having a top edge and a bottom edge separated by a distance h and a center defined by the distance $h/2$ such that the centers are allowed to be non-planar, as claimed.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

In light of the foregoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §103(a) have been traversed, and respectfully request that the Examiner reconsider and withdraw these rejections.

Regarding New Claims 32-34

Applicant has added new Claims 32-34 directed to a shimming system wherein the top edge of the shim has a surface area smaller than the face surfaces of the shim, which finds support in the specification as originally filed at Paragraph [0033]. No new matter has been added.

Accordingly, Applicant submits that new Claims 32-34 are directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

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The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP

Applicant's Attorneys

By: 

David Arnold

Registration No: 48,894

Customer No. 23413

Address: 55 Griffin Road South, Bloomfield, Connecticut 06002
Telephone: (860) 286-2929
Fax: (860) 286-0115